REMARKS

Claims 1-26 are currently pending in the subject application and are presently under consideration. Favorable consideration of the subject patent application is respectfully requested in view of the comments herein.

I. Rejection of Claims 1-4, 7-9, 13, 16, 18-19, 20-23 and 25-26 Under 35 U.S.C. §102(e)

Claims 1-4, 7-9, 13, 16, 18-19, 20-23 and 25-26 stand rejected under 35 U.S.C. §102(e) as being anticipated by Hirata (US 6,374,406). This rejection should be withdrawn for at least the following reasons. Hirata fails to teach or suggest each and every limitation set forth in the subject claims.

> A single prior art reference anticipates a patent claim only if it expressly or inherently describes ***each and every limitation set forth in the patent claim***. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The ***identical invention must be shown in as complete detail as is contained in the ... claim***. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

Independent claims 1, 8, 16, 20 and 22 recite similar claim limitations, namely, ***a token having a schema that identifies a corresponding program*** *so that a recording system receiving the token is programmable to record the program based on the token, the token being transportable between at least two computers.* Thus, it is apparent that the invention as claimed relates to a token schema that facilitates identification of a broadcast audio and/or visual program, the audio and/or visual program so identified by the token can be recorded on a token-enabled recording device based upon the schema information contained within the token associated with the broadcast audio and/or visual program. Hirata is silent regarding this particular novel feature of the claimed invention.

Hirata, discloses the use of electronic mail to program household appliances to perform a predetermined set of tasks. *See* col. 10, lines 49-54. This is in contrast to the invention as claimed which utilizes a token having a schema comprising a multi-level

data structure with a plurality of fields that stores different types of information and that identifies a corresponding audio and/or visual program for recording on a token-enabled recording device.

In the instant Advisory Action dated July 14, 2004, the Examiner states that applicants' representative's prior arguments in the Final Office Action dated May 10, 2004, failed to place the current application in condition for allowance. In particular, the Examiner asserts, "since Hirata's electronic mail on which a control command is interpolated and transmitted over a network, performs an *equivalent function*" that Hirata therefore teaches each and every limitation set forth in the subject claims and consequently anticipates the invention as claimed. The Court of Appeals for the Federal Circuit has descried the rationale of basing the standard of anticipation on mere *equivalency* as being at odds with the plain meaning of 35 U.S.C. §102; the standard set forth by the Court of Appeals for the Federal Circuit to which anticipation under 35 U.S.C. §102 is to be measured is ***strict identity***, i.e. a single reference must teach each and every limitation as set forth in the subject claims, not as the Examiner contends *equivalency*. *See e.g., Trintec Industries, Inc. v. Top-U.S.A. Corporation*, 295 F.3d 1292, 1296 (Fed. Cir. 2002). Thus, it is applicants' representative's contention that since Hirata does not expressly or inherently disclose ***a token having a schema*** identifying an associated audio and/or visual program, that Hirata does not teach or suggest ***each and every limitation as set forth in the subject claims***, and as a consequence therefore that Hirata does not disclose the ***identical invention*** as recited in the subject claims, and as is required to comport with the standard by which anticipation is to be measured.

In addition, the Examiner admits in the Advisory Action dated July 14, 2004, that the Microsoft Computer Dictionary (4th ed. 1999) definition of "token", to which applicants representative was directed in the Final Office Action dated May 10, 2004, does not correspond to the definition provided within applicants specification, but nevertheless asserts: "the fact remains that the e-mail description by Hirata is indeed *functionally equivalent* to the token as claimed, i.e. sent over a network, travels between devices, identifies a program to be recorded by identifying the channel, date and time for recording of a program." Advisory Action dated July 14, 2004 (emphasis added). As has been discussed *supra*, and is reiterated here, the test for anticipation under 35 U.S.C.

§102 is strict identity between the cited document and the invention as claimed. The Examiner's concession that the definition provided by the Microsoft Computer Dictionary does not correspond to applicants definition of a token is a clear indication that Hirata, though functionally equivalent, is not the identical conception as recited in the subject claims.

In view of at least the foregoing it is therefore respectfully requested that the rejection of independent claims 1, 8, 16, 20 and 22 (and associated dependent claims) be withdrawn.

II. Rejection of Claims 5-6, 10-12, 14-15, 17 and 24 Under 35 U.S.C. §103(a)

Claims 5-6, 10-12, 14-15, 17 and 24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hirata. This rejection should be withdrawn for at least the following reason. Claims 5-6, 10-12, 14-15, 17 and 24 depend from independent claims 1, 8, 16, 20 and 22, and for reasons stated *supra*, Hirata fails to cure the aforementioned deficiencies with respect to the independent claims from which the subject claims depend. Accordingly, withdrawal of this rejection is respectfully requested.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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